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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,875	01/12/2001	Jerome L. Krupa	P1329USA	2537
8968	7590	02/10/2005	EXAMINER	
GARDNER CARTON & DOUGLAS LLP ATTN: PATENT DOCKET DEPT. 191 N. WACKER DRIVE, SUITE 3700 CHICAGO, IL 60606			LEE, DIANE I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Supplemental*  
**Office Action Summary**

Application No.

09/759,875

Applicant(s)

KRUPA, JEROME L.

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/23/04 and 9/27/04.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 91-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 96-104 is/are allowed.
- 6) ☒ Claim(s) 91-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 12/16/04
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

**Note:** This is a Supplemental Office Action. This Supplemental Office Action supersedes the previous Office Action (mail date: 11/30/04). In the previous Office, the Examiner rejected claims 91-105 and 106-109, and the Examiner indicated that applicant has not provided arguments with respect to claims 91-95 and 105-109 in the Amendment filed 9/27/04. However, claims 106-109 have been canceled and applicant's arguments with respect to claims 91-95 and 105-109 were previously provided in the Amendment filed 8/23/04. Therefore, this Supplemental Office Action is to correct the error that was made in the previous Office Action. The examiner regrets any inconvenience to the applicant (see attached PTO-413).

1. Receipt is acknowledged of the Amendment filed 27 September 2004. Claims 91 and 105 have been amended; claims 106-109 have been canceled; and no claims have been newly added. Currently, claims 91-105 are remain pending in the application.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 91 -95 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over**  
**Blanford et al. [US 6,561,426-referred as Blanford].**

**Re claims 91, 94-95, and 105:** Blanford discloses a system having a first label (a primary label 102) having a single layer and a first machine-readable bar code and a second label (a supplemental label

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104) attached the product or container. The second label having a second machine readable bar code with a specific alignment with respect to the first bar code (i.e., the second label is attached in close proximity to the first label and the first bar code and the second bar code are substantially aligned side-by-side, such that the second bar code is positioned as to partially obscure the first bar code, see col. 3, lines 3+ and figure 1). Wherein the first bar code label provides information about a particular product (i.e., product identity) and the second bar code label identifies the particular product information desired to be distributed to a consumer, e.g., an indication that the identified product has been marked down (see col. 2, lines 13+). The system includes a scanner 202 capable of reading both the first and the second bar code and subsequently comparing the second bar code with the first to determine if the second bar code corresponds to the first bar code (i.e., applicant has not explicitly define the determining process of the second bar code corresponds to the first bar code when comparing the second bar code with the first bar code, and further, wherein the processing step of the supplemental label of Blanford, the examiner recognizes that in order to process the supplemental label, which indicates the marked down information of the product identified by the primary label, the system would have to verify the secondary label with respect to the primary label by comparing the secondary bar code with the primary bar code to determine if the secondary bar code corresponds to the primary bar code when conducting the price reducing transaction, such as verifying the product's original/regular price identified by the primary label and the marked down price of the product identified by the secondary label, see col. 2, lines 20+, also Hipko US 4,540,880, Kaslow US 3,959,624 for example). Thus, the processing step of the supplemental label of Blanford meet the limitation of the system subsequently comparing the second bar code with the first to determine if the second bar code corresponds to the first bar code.

With respect to the container suitable for a pharmaceutical and the second bar code identifying the particular pharmaceutical desired to be distributed to a patient, a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior

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art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Although Blanford teaches that the first and second bar code are fully readable (i.e., the scanner 202 is adapted to detect and read a primary label 102 and to detect and register a supplemental label 104, see col. 3, lines 19+) and subsequently comparing the second bar code with the first to determine if the second bar code corresponds to the first bar code, Blanford fails to teach the scanner capable of reading both the first and the second bar code simultaneously. However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the old and well-known imaging system (see Moed US 5,770,841 and Wang US 5,304,787 for example), such as CCD that capable of simultaneously capturing the multiple image of the bar codes in the system of Blanford in order to reduce the scanning time by simultaneously capturing the first and the second bar code by imaging.

**Re claim 92:** the fact that applicant has not explicitly described the first portion and the second portion of the second label, the second label of Blanford (i.e., the supplemental label) having many portions (i.e., an upper portion having an upper left portion and an upper right portion, a lower portion having a lower left portion and a lower right portion, a left portion, a right portion, and a center portion, and etc.) meet the claimed limitation. Thus, one of the above portions from the second label of Blanford is aligned with the first bar code (see figure 1).

**Re claim 93:** Blanford does not teach the first portion includes at least one of typewritten and a handwritten prescription information.

However, it would have been an obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the label, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability, *In re Gulack* 217 USPQ 401, (CAFC 1983). The

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fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information for the container does not alter the functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printer matter and the substrate that is required for patentability.

### ***Allowable Subject Matter***

4. Claims 96-104 are remain allowed.
5. The following is an examiner's statement of reasons for allowance: the best prior art of the records fails to teach or fairly suggest the a pharmaceutical container having a symbol with specifics claimed single-layered label having first outer boundary portion and second outer boundary portion extending out and away from the outer boundary of the first portion and wherein the second portion having a patient identifying indicium aligned with the symbol of the container so as to allow both the symbol and the indicium to be scanned together by a detector in order to confirm the contents of the pharmaceutical container, as set forth in the claim.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

6. Although Applicant has provided no arguments with respect to claims 91-95 and 105-109 in the Amendment filed 27 September 2004, Applicant's arguments filed 8/23/2004 have been fully considered but they are not persuasive.
7. Applicant argued that the teaching of Blanford does not render obvious the claimed invention by pointing out that Blanford discloses a secondary label that is placed over a primary label so as to partially

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obscure the primary label, and claims 91 and 105, amended, are directed to a system where the second label is attached to the container in close proximity to the first label such that the bar code or identifying indicia on both the first and second labels are fully readable, and Applicant further pointed out that because Blanford does not disclose a system that positions a primary and secondary label in such a manner so as to allow the indicia on both labels to be fully readable (see page 5, lines 16+). The Examiner respectfully disagrees. Contrary to the Applicant's argument, the Examiner believes that the Applicant misinterprets the claim. Although Blanford teaches the position of the primary is partially obscured by the secondary labels, Blanford clearly teaches that the second label is attached to the container in close proximity to the first label such that the bar code or identifying indicia on both the first and second labels are fully readable (i.e., the scanner 202 capable of reading both the first and the second bar code to determine if the second bar code corresponds to the first bar code, see col. 3, lines 19+). The fact that the scanner 202 of Blanford is adapted to **detect** and **read** both the first and the second bar codes and process thereafter, Blanford clearly teaches that both the first and second labels are fully readable. Thus, the Applicants' argument on this point is not persuasive.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hipko [US 4,540,880] and Kaslow [US 3,959,624] discloses a system reading the first bar code and the second bar code and subsequently comparing the second bar code with the first bar code to determine if the second bar code corresponds to the first bar code; and

Wang [US 5,304,787] discloses an optical imaging system capturing multiple bar codes simultaneously.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee  
Primary Examiner  
Art Unit 2876

D. L.